



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,487	08/21/2009	6505172	54848-5016-US	8473

70813 7590 01/13/2011
GOODWIN PROCTER LLP
901 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20001

EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
----------	--------------

3992

MAIL DATE	DELIVERY MODE
-----------	---------------

01/13/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

DO NOT USE IN PALM PRINTER

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MERCHANT & GOULD PC
P O BOX 2903
MINNEAPOLIS, MN 55402-0903

Date: **MAILED**

JAN 13 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000487
PATENT NO. : 6505172
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

DO NOT USE IN PALM PRINTER

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

MERCHANT & GOULD PC

P O BOX 2903

MINNEAPOLIS, MN 55402-0903

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000487

PATENT NO. : 6505172

TECHNOLOGY CENTER : 3999

ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Right of Appeal Notice
(37 CFR 1.953)**

Control No.

95/000,487

Examiner

JOSEPH R. POKRZYWA

Patent Under Reexamination

6505172

Art Unit

3992

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address. --

Responsive to the communication(s) filed by:

Patent Owner on 9 August 2010

Third Party(ies) on 8 September 2010

Patent owner and/or third party requester(s) may file a notice of appeal with respect to any adverse decision with payment of the fee set forth in 37 CFR 41.20(b)(1) within **one-month or thirty-days (whichever is longer)**. See MPEP 2671. In addition, a party may file a notice of **cross** appeal and pay the 37 CFR 41.20(b)(1) fee **within fourteen days of service** of an opposing party's timely filed notice of appeal. See MPEP 2672.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

If no party timely files a notice of appeal, prosecution on the merits of this reexamination proceeding will be concluded, and the Director of the USPTO will proceed to issue and publish a certificate under 37 CFR 1.997 in accordance with this Office action.

The proposed amendment filed _____ ☐ will be entered ☐ will not be entered*

*Reasons for non-entry are given in the body of this notice.

- 1a. ☒ Claims 1-5 are subject to reexamination.
- 1b. ☐ Claims _____ are not subject to reexamination.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are confirmed. [Unamended patent claims].
4. ☐ Claims _____ are patentable. [Amended or new claims].
5. ☒ Claims 1-5 are rejected.
6. ☐ Claims _____ are objected to.
7. ☐ The drawings filed on _____ ☐ are acceptable. ☐ are not acceptable.
8. ☐ The drawing correction request filed on _____ is ☐ approved. ☐ disapproved.
9. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119 (a)-(d) or (f). The certified copy has:
☐ been received. ☐ not been received. ☐ been filed in Application/Control No. _____
10. ☐ Other _____

Attachments

1. ☐ Notice of References Cited by Examiner, PTO-892
2. ☒ Information Disclosure Citation, PTO/SB/08
3. ☐ _____

Application/Control Number: 95/000,487

Page 2

Art Unit: 3992

DETAILED ACTION

Summary of Proceedings

1. Claims 1-5 originally issued in U.S. Patent Number 6,505,172 (hereafter “the ‘172 Patent”) on January 7, 2003. During this *inter partes* reexamination proceeding, no amendments by the Patent Owner were made to claims 1-5, therein claims 1-5 remain in their original patented state.

2. With the Patent Owner’s current response dated 8/9/2010, which is responding to the Action Closing Prosecution dated 7/8/2010, claims 1-5 of the ‘172 Patent remain subject to the current reexamination proceeding. The Third Party Requester submitted comments on 9/8/2010 in response to these arguments by the Patent Owner.

Application/Control Number: 95/000,487

Page 3

Art Unit: 3992

Information Disclosure Statement

3. The references listed in the Information Disclosure Statement submitted on 9/10/2010 have been considered by the examiner (see attached PTO/SB/08A).

4. Continuing, the examiner notes that the Court documents submitted in the above noted Information Disclosure Statement have been received, and considered, but are not proper to be listed on an Information Disclosure Statement, as the documents are not proper to be printed on the face of a Reexamination Certificate, once issued. Thus, this citation has been indicated as having a line through the citation in the Information Disclosure Statement.

Application/Control Number: 95/000,487

Page 4

Art Unit: 3992

Cited Prior Art of Record

5. The Action Closing Prosecution dated 7/8/2010 cites the following prior art patents and printed publications in rejections that render claims 1-5 of the '172 Patent as unpatentable:

- a. U.S. Patent Number 6,963,551, issued to Doyle *et al.* (noted as the “Doyle ‘551 Patent”);
- b. U.S. Patent Number 5,712,989, issued to Johnson *et al.* (noted as “the ‘989 Patent”);
- c. “A Practical Guide to SABRE Reservations and Ticketing”, written by Jeanne Semer-Purzycki, having a copyright date of 1992 (noted as the “SABRE Practical Guide”);
- d. J-CON Manual, Volume 1, published by Cooperative Computing Incorporated, April 1994 (noted as the “J-CON Manual”);
- e. “Gateway 2000/MRO Version Manual” published by TSA incorporated, being dated May 1991 (noted as the “Gateway 2000/MRO Version Manual”); and
- f. P.O. Writer Plus V.10 Manual, 1993 (noted as the “P.O. Writer Plus Manual”).

Application/Control Number: 95/000,487

Page 5

Art Unit: 3992

Ground's for Rejection

6. In the Action Closing Prosecution dated 7/8/2010, the adopted grounds for rejection of claims 1-5 of the '172 Patent were as follows:

Ground#1.

Claims 1-5 of the '172 Patent to be rejected under 35 U.S.C. 102(e) as being anticipated by the Doyle '551 Patent. This rejection of claims 1-5, as being anticipated by the Doyle '551 Patent, remains adopted.

Ground#2.

Claims 1 and 3-5 of the '172 Patent to be rejected under 35 U.S.C. 102(e) as being anticipated by the Johnson '989 Patent. This rejection of claims 1 and 3-5, as being anticipated by the Johnson '989 Patent, remains adopted.

Ground#4.

Claims 1-5 of the '172 Patent to be rejected under 35 U.S.C. 102(b) as being anticipated by the SABRE Practical Guide. This rejection of claims 1-5, as being anticipated by the SABRE Practical Guide, remains adopted.

Application/Control Number: 95/000,487

Page 6

Art Unit: 3992

Ground#7.

Claims 1-5 of the '172 Patent to be rejected under 35 U.S.C. 102(b) as being anticipated by P.O. Writer Plus Manual. This rejection of claims 1-5, as being anticipated by the P.O. Writer Plus Manual, remains adopted.

Ground#8.

Claims 1-5 of the '172 Patent to be rejected under 35 U.S.C. 102(e) as being anticipated by the J-CON Manual. This rejection of claims 1-5, as being anticipated by the J-CON Manual, remains adopted.

Ground#9.

Claims 1-5 of the '172 Patent to be rejected under 35 U.S.C. 102(b) as being anticipated by the Gateway 2000/MRO Manual. This rejection of claims 1-5, as being anticipated by the Gateway 2000/MRO Manual, remains adopted.

Application/Control Number: 95/000,487

Page 7

Art Unit: 3992

Response to the Third Party Comments

7. The examiner generally agrees with the comments provided by the Third Party Requester on 9/8/2010. The Third Party Requester's comments respond to the arguments provided by the Patent Owner filed on 8/9/2010.

Response to Patent Owner's Arguments

8. The Patent Owner's arguments filed 8/9/2010 have been fully considered but they are not persuasive. In the arguments dated 8/9/2010, beginning on page 2, the Patent Owner addresses three main points that are alleged to be errors made by the examiner in the Action Closing Prosecution (ACP), dated 7/9/2010.

9. First, the Patent Owner argues that in the ACP dated 7/8/2010, the interpretations set forth in the declaration of Brooks Hilliard dated 1/25/2010 were improperly dismissed, whereby the Patent Owner contends that these interpretations are the broadest reasonable interpretations. Specifically, on page 2 of the arguments, the Patent Owner states "the Patent Owner submitted the Hilliard Decl. that *inter alia* set forth the proper interpretations of several claim terms." Additionally, the Patent Owner argues that in the ACP dated 7/8/2010, the examiner failed to establish why broader interpretations are reasonable interpretations that are consistent with the specification.

Application/Control Number: 95/000,487

Page 8

Art Unit: 3992

10. With this, reviewing the prosecution history, as discussed in the ACP dated 7/8/2010, the Patent Owner, as further discussed in the Hilliard Declaration, defines an “Electronic Sourcing System” as “An electronic system for use by a prospective buyer to locate and find items to purchase from sources, suppliers, or vendors.” However, the examiner notes that there is no requirement of a “prospective buyer” in the current language, and the broadest reasonable interpretation of the term “electronic sourcing system” would simply be “an electronic system to find items for purchase”. Further, nowhere in the specification of the ‘172 Patent is the term “prospective buyer” discussed. Thus, the Patent Owner’s alleged broadest reasonable interpretation is not seen to be consistent with the specification of the ‘172 Patent.

11. Additionally, the examiner notes that in col. 17, lines 1-29, the ‘172 Patent describes that a “Customer end user or a Customer purchasing employee” can utilize the system, and additionally states in col. 18, lines 23-42 that a “distributor purchasing employee” can utilize the system, acting as an interface with the customer. With this, in this embodiment discussed in the specification of the ‘172 Patent, the distributor is not the “prospective buyer”, but rather an interface to the “customer”. Thus, the Patent Owner’s interpretation of the term “Electronic Sourcing System” provided in the Hilliard Declaration is not the broadest reasonable interpretation of the term that is consistent with the specification of the ‘172 Patent. Rather, the broadest reasonable interpretation of the term “electronic sourcing system” would simply be “an electronic system to find items for purchase”, which is seen to be consistent with the specification of the ‘172 Patent.

Application/Control Number: 95/000,487

Page 9

Art Unit: 3992

12. Continuing, in the Declaration of Hilliard, on pages 9 and 10, the Declaration expressly states “In performing my analysis of the proper interpretation to be given to the claims of the ‘172 Patent, I have followed the Supreme Court’s teaching in *Markman v. Westview Instruments*. I understand that *Markman* provides that when construing the terms of a patent claim, I should first look to the ‘intrinsic evidence’ for their meaning, starting with the language of the claims themselves....” Thus, the interpretations provided in the Declaration of Mr. Hilliard, which are discussed and appear to be adopted in the previous arguments by the Patent Owner, are drawn to the manner in which a court would interpret claims, and not necessarily the broadest reasonable interpretation standard that is used by the PTO.

13. In this regard, the examiner notes that MPEP 2111 [R-5] states, in part:

...See also *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that **the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit**. Rather, the “PTO applies to verbiage of the proposed claims **the broadest reasonable meaning** of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.”).
[Emphasis added].

14. Additionally, MPEP 2111 [R-5] states, in part:

During patent examination, the pending claims **must be “given their broadest reasonable interpretation consistent with the specification.”** >The Federal Circuit’s *en banc* decision in *Phillips v. AWfCorp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005)

Application/Control Number: 95/000,487

Page 10

Art Unit: 3992

expressly recognized that the USPTO employs the “broadest reasonable interpretation” standard:

The Patent and Trademark Office (“PTO”) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech. Cir.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must “conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.” 37 CFR 1.75(d)(I).

415 F.3d at 1316, 75 USPQ2d at 1329. See also *In re Hyatt*, 2.11 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). **Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified.** *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541,550-51 (CCPA 1969). [Emphasis added]

15. Therefore, the claim terms are to be interpreted under the “broadest reasonable interpretation” standard. With this, as discussed in the ACP, the term “catalog” is defined in the Declaration of Mr. Hilliard as “an organized collection of items and associated information which typically includes, for example, a part number, price, catalog number, vendor name, vendor ID, a textual description of an item, and images of or relating to the item”, whereby the inclusion of the phrase “which typically includes, for example, a part number, price, catalog number, vendor name, vendor ID, a textual description of an item, and images of or relating to the item” is not part of the broadest reasonable interpretation of the term. The definition

Application/Control Number: 95/000,487

Page 11

Art Unit: 3992

provided in the Hilliard Declaration would not be the broadest reasonable interpretation, as the examiner believes that the broadest reasonable interpretation of the term would simply be “an organized collection of items and information. Further, as noted in the ACP dated 7/8/2010, the term “catalog” does not even appear in any of claims 1-5 of the ‘172 Patent.

16. Further, the Patent Owner defines a “requisition” as “a formal request to purchase something”, “purchase order” as “a commission or instruction to buy something”, and “source” as “when used as a noun, a supplier, vendor or distributor of products or services.” However, the examiner notes that these definitions are not seen to be the broadest, reasonable definitions of the terms that is consistent with the specification. For instance, a “requisition” can simply be “a request to purchase something”, whereby there is no requirement of the request being a “formal request”. Further, a “purchase order” can be “an order to buy something”, and a “source” can be “an origination of something”, not necessarily being “a supplier, vendor, or distributor”.

17. Continuing, on page 3, the Patent Owner argues that “in the ACP, includes numerous instances where unreasonably broad claim interpretations are employed that are inconsistent with the meanings of such terms as used in the specification.” and “the Examiner asserts that the part number lookup function of the ‘989 Patent shows the limitation of claim 1 that the database is ‘maintained such that selected portions of the database may be searched separately.’...A part number lookup is not structurally equivalent to conducting a search of selected portions of the database using a search engine program, as described in the patent specification and claims. The

Application/Control Number: 95/000,487

Page 12

Art Unit: 3992

claims of the patent are written in means plus function format and require analysis under the sixth paragraph of 35 U.S.C. 112.”

18. In this regard, claim 1 requires “means for searching for matching items that match the entered product information in the selected portions of the database”. But looking at the structure described in the specification of the ‘172 Patent, the “means for searching” is not described as a “search engine program”. Rather, in col. 4, lines 6-14, the ‘172 Patent states “Electronic sourcing system 5 also includes a requisition/purchasing system 40, preferably but not necessarily the Fisher RIMS system, and a search program 50 that is capable of searching through large volumes of information quickly and accurately. Preferably but not necessarily, the Technical Viewer 2 search program (“TV/2”), available from IBM, is used as search program 50.” With this, the means for searching, as described in the specification of the ‘172 Patent, is a “search program”. As described in the ACP, the various references cited in the rejections teach of “programs” that provide the searching function.

19. In the previous response, the Patent Owner pointed to the Hilliard Declaration, which describes the function being performed by a “search engine”. However, as noted above, the specification of the ‘172 Patent does not expressly describe the function described in the Hilliard Declaration. Recall that the claims are interpreted in the broadest reasonable interpretation standard, in light of the specification. With this the programs that perform a searching function described in the cited prior art, are in a broad and reasonable manner, consistent with the

Application/Control Number: 95/000,487

Page 13

Art Unit: 3992

specification of the '172 Patent, are seen to teach of a "means for searching for matching items that match the entered product information in the selected portions of the database".

20. Additionally, as discussed in the comments provided by the Third Party Requester on page 2, "The Patent Owner continues to press for adoption of Mr. Hilliard's narrower constructions of the claim terms. See Comments dated August 9, 2010 at 3 ('Mr. Hilliard sets forth the broadest reasonable interpretation of the claims.'). However, since the Patent Owner's last response, broader interpretations than those provided by Mr. Hilliard were adopted by a court in copending litigation....Because Mr. Hilliard's constructions are narrower than have been adopted by the Court, they are necessarily not the broadest reasonable constructions." The examiner agrees with the Third Party Requester's observation, in that the Court adopted interpretations that are narrower than those defined in the Hilliard Declaration. Thus, those definitions found in the Hilliard Declaration would not necessarily be the "broadest reasonable interpretation", as the Court's interpretations are narrower, and the broadest reasonable interpretation is different, and typically broader than the standard that the Court uses to interpret claim language.

21. Continuing, on page 3 of the arguments, the Patent Owner points to the Deposition of Laurence McEneny to rebut the teachings discussed in the P.O. Writer Plus Guided Tour (Particularly, page 49, line 2-page 51, line 2, which states "You can now buy this item from Best Buy, Bayless or any other vendor you would like to select."), whereby the Patent Owner states that "This citation fails to show that selected portions of the database may be searched

Application/Control Number: 95/000,487

Page 14

Art Unit: 3992

separately. Rather, this excerpt simply indicates that the item has previously been purchased from Best Buy and Bayless.”

22. However, on page 49, lines 4-12, the McEneny Deposition states “On this particular screen, which is on creating a purchase order, this screen would typically be used by a buyer. And a buyer in this product was not limited on who they could buy from. So they could buy from, in this example, the two suppliers that are shown, Best Buy or Bayless, or the buyer could pick another supplier that was in the P.O. Writer Plus vendor master file.” Further, on page 41, line 21-page 42, line 5, the McEneny Deposition describes “So if a user was going to look for an item, and they weren’t really sure who they could buy it from, it was common practice, and we educated people ...to say things like preferred supplier or primary supplier , alternate supplier.” Thus, the P.O. Writer Plus Guided Tour reference is still seen to teach the limitation that “selected portions of the database may be searched separately”, as separate suppliers can be searched separately.

23. Continuing, on page 4, the Patent Owner argues that the current claim language requires an “order list”, and the inclusion of the term “ordered list” in the ACP, as pointed out by the Patent Owner was in error by the examiner. With this, the examiner agrees that the current language does not include the term “ordered list”, and the inclusion of the term was in error by the examiner. However, the arguments set forth by the examiner in the ACP remain the same with the term “order list”, as the list of flights shown on page 29 of the ACP is seen as being an “order list”, being a “list of desired items”.

Application/Control Number: 95/000,487

Page 15

Art Unit: 3992

24. Continuing, the Patent Owner argues on page 4 that that the specification of the '172 Patent clearly distinguishes between a "hit list" and an "order list", and the Patent Owner appears to argue that the list of flights from page 54 of the SABRE Practical Guide would be considered as a "hit list". Particularly, the Patent Owner argues on page 4 that "To interpret the order list as the list of the results of the search is an unreasonably broad interpretation that is not consistent with the specification." However, with this, the reference of the SABRE Practical Guide describes that the customer selects the particular entry from the results of the search. This selection is considered as the "order list". Further, the examiner notes that currently claim 1 does not distinguish between a "hit list" and an "order list", but rather this limitation is found in dependent claim 2. If the Patent Owner wishes that this distinction be given to the term "order list" within independent claim 1, then the claim must be amended accordingly.

25. Additionally, in the arguments dated 8/9/10, the Patent Owner points to page 76, lines 4-22 of the Deposition of Jesus Ramos to show that the Gateway 2000/MRO Manual does not describe a "means for generating an order list". Particularly, this section describes that there was no "shopping cart", and that the selected items were placed directly into the requisition form. In this regard, a "shopping cart" is not required in the current language, but rather claim 1 specifically states "means for generating an order list that includes at least one matching item selected by said means for searching". As noted above, the Patent Owner argues that the specification of the '172 Patent distinguishes between an "order list" and a "hit list". But this difference is not apparent with the current language of independent claim 1. While dependent

Application/Control Number: 95/000,487

Page 16

Art Unit: 3992

claim 2 does introduce a “hit list”, and distinguishes between the “order list”, with respect to independent claim 1, this difference is not apparent.

26. But in reviewing the Gateway 2000/MRO Manual, on page 4-18 through page 4-19, the Gateway 2000/MRO Manual describes the function of “catalog ordering”. First on page 4-18, the reference states “To select items from a standard catalog, position the cursor at the beginning of a new line item description and press the F7 key. A list of pre-stored catalog names will be displayed....Catalogs contain a heading that describes the catalog plus the vendor name and catalog name...To select a catalog, move the lightbar to the desired catalog and press enter. The items listed in this catalog will be displayed for selection.” This display of items is seen to equate to the “order list” in the current claim language. Further, on page 4-19, the Gateway 2000/MRO Manual states “When a catalog has been selected, the items listed in that catalog will be displayed on the screen in a catalog items window. To choose from a catalog position the lightbar to the desired item and press enter. A window will be displayed for entry of the quantity required. Enter a quantity. The system will return for another selection. Repeat this process for each item required. When all items have been selected, press the F8 key to move all of the selected items into the order. Press the F2 on an item to see the full description.” With this, the Gateway 2000/MRO Manual is seen as teaching “means for generating an order list that includes at least one matching item selected by said means for searching”, as currently required in independent claim 1.

Application/Control Number: 95/000,487

Page 17

Art Unit: 3992

27. Continuing, on pages 4 and 5, the Patent Owner argues that another error made by the examiner in the ACP dated 7/8/2010 is that the '989 Patent is improperly applied in a rejection, whereby the Patent Owner states that the Examiner improperly attempts to use the inventor's own inventive efforts against them. But, as discussed in the ACP dated 7/8/2010, the instant '172 Patent was invented by Johnson, Momyer, Kinross, and Melly, whereby the previously filed '989 Patent includes the inventive entity of only Johnson and Momyer. Thus, the instant latter filed '172 Patent includes the inventors of Kinross and Melly, not being part of the previously filed '989 Patent, therein being a different inventive entity. With this, the instant '172 Patent was invented "by another" with respect to the '989 Patent.

28. Continuing, the Patent Owner argues on page 5 that the Declarations of Johnson and Momyer under 37 CFR 1.132 submitted by the Patent Owner show that the subject matter disclosed and claimed in the '989 Patent were invented by Johnson and Momyer, and the examiner attempts to use the inventors' own inventive efforts against them. But as noted above, the current inventive entity of the '172 Patent is Johnson, Momyer, Kinross, and Melly, being invented "by another" than the inventive entity of the '989 Patent, which is just Johnson and Momyer. With this, the examiner believes that the Declarations of Johnson and Momyer still are insufficient to overcome the rejection of claims 1, and 3-5 of the '172 Patent, as being anticipated by the '989 Patent.

Application/Control Number: 95/000,487

Page 18

Art Unit: 3992

29. Continuing, the Patent Owner argues on pages 7-9, that the third error made in the ACP dated 7/8/2010, was that the examiner improperly concludes that several manuals applied against the claims are “printed publications” as the term is used in 35 U.S.C. 102. The Patent Owner states on page 8 that “The Examiner, in the ACP, does not establish why the persons or companies that purchased the corresponding software constitute the relevant portion of the public concerned with the art.” The Patent Owner then cites numerous court decisions on pages 8 and 9. Of interest, the examiner notes that on page 8 of the Patent Owner’s arguments, the Patent Owner cites “...*Cooper Cameron Corp. v. Kvaerner Oilfield Prods. Inc.*, 291 F.3d 1317, 62 U.S.P.Q.2d 1846 (Fed. Cir. 2002) (joint venture members and participants and their contractors and licensees **may be the interested public for which access is required to show publication**)...” [Emphasis added.]

30. In this regard, in reviewing the *Cooper Cameron Corp. v. Kvaerner Oilfield Prods. Inc.* Decision, the examiner notes that in the discussion titled “C. Printed Publications”, the Decision states:

Finally, on remand the district court should take into consideration that reports need only be accessible to the interested public, *Mass. Inst. of Tech. v. AB Fortia*, 744 F.2d 1104, 1109, 227 USPQ 428, 432 (Fed. Cir. 1985), **which in this case may be the very entities who had access to the documents**: SISL joint venture members, participants, and their contractors and **licensees**. This does not appear to be a case in which documents shared with joint venture members are maintained in confidence. **Here, those with access to the documents were asserted to be a significant portion of the interested public.**

Application/Control Number: 95/000,487
Art Unit: 3992

Page 19

31. With this, the J-CON Manual, the P.O. Writer Plus Manual, and the Gateway 2000/MRO Manual were given access to the portion of the public concerned with the art, being those persons or companies who purchased, or licensed the software. Thus, the examiner believes that the rejection of the claims of the '172 Patent with theses documents, under 35 U.S.C. 102 is proper, as the documents are seen to be "printed publications".

Notice of the Right of Appeal

32. **This is a RIGHT OF APPEAL NOTICE (RAN);** see MPEP § 2673.02 and § 2674. The decision in this Office action as to the patentability or unpatentability of any original patent claim, any proposed amended claim and any new claim in this proceeding is a FINAL DECISION.

No amendment can be made in response to the Right of Appeal Notice in an *inter partes* reexamination. 37 CFR 1.953(c). Further, no affidavit or other evidence can be submitted in an *inter partes* reexamination proceeding after the right of appeal notice, except as provided in 37 CFR 1.981 or as permitted by 37 CFR 41.77(b)(1). 37 CFR 1.116(f).

Each party has a **thirty-day or one-month time period, whichever is longer**, to file a notice of appeal. The patent owner may appeal to the Board of Patent Appeals and Interferences with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent by filing a notice of appeal and paying the fee set forth in 37 CFR 41.20(b)(1). The third party requester may appeal to the Board of Patent Appeals and

Application/Control Number: 95/000,487

Page 20

Art Unit: 3992

Interferences with respect to any decision favorable to the patentability of any original or proposed amended or new claim of the patent by filing a notice of appeal and paying the fee set forth in 37 CFR 41.20(b)(1).

In addition, a patent owner who has not filed a notice of appeal may file a notice of cross appeal within **fourteen days of service** of a third party requester's timely filed notice of appeal and pay the fee set forth in 37 CFR 41.20(b)(1). A third party requester who has not filed a notice of appeal may file **a notice of cross appeal within fourteen days of service** of a patent owner's timely filed notice of appeal and pay the fee set forth in 37 CFR 41.20(b)(1).

Any appeal in this proceeding must identify the claim(s) appealed, and must be signed by the patent owner (for a patent owner appeal) or the third party requester (for a third party requester appeal), or their duly authorized attorney or agent.

Any party that does not file a timely notice of appeal or a timely notice of cross appeal will lose the right to appeal from any decision adverse to that party, but will not lose the right to file a respondent brief and fee where it is appropriate for that party to do so. If no party files a timely appeal, the reexamination prosecution will be terminated, and the Director will proceed to issue and publish a certificate under 37 CFR 1.997 in accordance with this Office action.

Application/Control Number: 95/000,487
Art Unit: 3992

Page 21

Conclusion

33. All correspondence relating to this *inter partes* reexamination proceeding should be directed:

By Mail to: Mail Stop *Inter Partes* Reexam
Attn: Central Reexamination Unit
Commissioner of Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
Randolph Building
401 Dulany St.
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

Signed:

/Joseph R. Pokrzywa/

Joseph R Pokrzywa
Primary Patent Examiner
Central Reexamination Unit 3992
(571) 272-7410

Conferees: /r.g.f./

ESK